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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,387	08/29/2003	Ken Hamilton	HAMK-26,430	9246
25883	7590	05/01/2008		
HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 DALLAS, TX 75374-1715			EXAMINER NGUYEN, TAN D	
			ART UNIT 3689	PAPER NUMBER
			NOTIFICATION DATE 05/01/2008	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@dalpat.com

### Office Action Summary

**Application No.**

10/651,387

**Applicant(s)**

HAMILTON, KEN

**Examiner**

Tan Dean D. Nguyen

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-23 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SI-108)  
Paper No(s)/Mail Date 1/12/04 & 3/29/04  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 1-23 are pending. They include: 1-11, 13-21 (system<sup>1</sup>), 12 (method<sup>1</sup>), 22 (system<sup>2</sup>) and 23 (method<sup>2</sup>).

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 1/12/04 and 3/29/04 was filed after the mailing date of the application on 8/29/03. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-11, 12-21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims deal with a system contain a decision group and a model base. They appear to be an apparatus or machine claims but there are no claimed elements or structures or functional elements normally present in an apparatus claim. Note that in an apparatus claim, the claims must be structurally distinguishable from the prior art. While features of an apparatus claim may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d

1429, 1431-32 (*Fed. Cir. 1997*). Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. vs. Bausch & Lomb Inc.* (*Fed. Circ. 1990*).

Therefore, items of claim 1 above, a group and a model base and how the group interacts by organizes...., are not structural elements or structures.

***Claim Rejections - 35 USC § 112***

4. Claims 12-21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Claims 13-21 which call for "The method of claim 11" which are vague since claim 11 is a system claim which is part of system claim 1.

As of 08/29/03, independent method claim 12 is as followed:

12. A method of performing decision analysis comprising the steps of:

- (a) defining a decision for decision analysis;
- b) assigning an expert to a first decision group;
- c) organizing the decision analysis into decision components;
- d) communicating a decision components to a first decision group;
- e) selecting one or more models from a model base by the first decision group;
- f) applying the selected model by the expert assigned to the first decision group;
- g) reporting decision analysis results;

(h) aggregating decision analysis results to generate aggregated decision analysis results;

(i) reporting the aggregated decision analysis results to the first decision group.

Note: for convenience, letters (a)-(i) are added to the beginning of each step.

2) In claim 12, it's not clear what it means by "(f) applying the selected model by the expert" to do what? How the result of step (g) is determined or the term "decision analysis results" lack antecedent basis.

3) Steps (h) and (i) are not clear since the decision analysis results are carried out by the first decision group.

4) Independent method claim 23 which has similar limitations to independent method claim 12 above and is therefore rejected for the same reasons set forth in the rejections of claim 12 above.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3689

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 12 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over MCDM Article, "Excellent for Service Level, Change and Risk Management" Article.

As of 08/29/03, independent method claim 12 is as followed:

12. A method of performing decision analysis comprising the steps of:

- (a) defining a decision for decision analysis;
- b) assigning an expert to a first decision group;
- c) organizing the decision analysis into decision components;
- d) communicating a decision components to a first decision group;
- e) selecting one or more models from a model base by the first decision group;

Art Unit: 3689

f) applying the selected model by the expert assigned to the first decision group;

g) reporting decision analysis results;

(h) aggregating decision analysis results to generate aggregated decision analysis results;

(i) reporting the aggregated decision analysis results to the first decision group.

Note: for convenience, letters (a)-(i) are added to the beginning of each step.

Similarly, MCDM Article, wherein MCDM appear to be the abbreviation of "Multiple-Criteria Decision-Making", discloses a method of performing decision analysis comprising the steps of:

(a) defining a decision for decision analysis; {see page 2, 1<sup>st</sup> paragraph}

b) assigning an expert to a first decision group;

{see page 2, section 4.3, page 3, section 4.3.2.}

c) organizing the decision analysis into decision components; {see page 2, section 4.3}

d) communicating a decision components to a first decision group; {see page 2, 1<sup>st</sup> paragraph, page 3}

e) selecting one or more models from a model base by the first decision group;

{see page 2 and page 3}

f) applying the selected model by the expert assigned to the first decision group;

{see pages 2-3}

g) reporting decision analysis results; {see page 2, 1<sup>st</sup> full paragraph, page 3}

(h) aggregating decision analysis results to generate aggregated decision analysis results;

{see page 1}

(i) reporting the aggregated decision analysis results to the first decision group.

{see pages 2-3}.

Alternatively, the use of the "Multiple-Criteria Decision-Making" model for other business decision would have been obvious as mere applying the same model to other business application in view of the teachings of multiple business applications on pages 5-16.

As for independent method claim 22 which deals with a specific type of decision or business, i.e. a service management, this is taught on page 13 "...*Service management...*". Alternatively, the use of the "Multiple-Criteria Decision-Making" model for other business decision such as service management would have been obvious as mere applying the same model to other business application.

No claims are allowed.



Art Unit: 3689

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689  
April 26, 2008